

REMARKS

This Amendment is filed in response to the Office Action dated May 30, 2003. Claims 113-119 and 126-135 are pending in this application. Applicants thank the Examiner for the indication that claim 130 is allowable and that claims 115 and 116 would be allowable if rewritten in independent form to include the limitations of the base claim and any intervening claim. Applicants have rewritten claims 115-117 in independent form as claims 134-136 to include the limitations contained in claim 113. Claims 113, 129, 131 and 132 have been amended. No new matter has been added.

The Examiner rejected claims 113-114 and 126-129 under 35 U.S.C. § 102(e) as being anticipated by Safar (U.S. Patent No. 5,802,593). Applicants have amended claims 113 and 129 to include the step of expanding the occluding member by passing an inflation fluid through a flow passage formed by the inner tubular member and the outer tubular member. Safar does not teach or suggest a method of positioning a catheter in a patient's ascending aorta between the patient's coronary ostia and the patient's brachiocephalic artery that includes a step of expanding an occlusion member by passing an inflation fluid through a flow passage formed by the inner tubular member and the outer tubular member. Instead, Safar passes an inflation fluid through a separate lumen—either first pilot tubing 280 or second pilot tubing 281—to inflate balloons 282 or 283, respectively. Applicants submit claims 113 and 129 are thus novel over Safar, as are claims 114 and 126-128, which depend from claim 113. As a result, Applicants request the Examiner to respectfully withdraw the 102 rejection.

The Examiner rejected claims 117-119 and 131-133 under 35 U.S.C. § 103(a) as being unpatentable over Safar in view of Kantrowitz (U.S. Patent No. 4,733,652). Applicants respectfully traverse this rejection.

Claims 117 is allowable for the same reasons stated above in connection with claim 113. Claim 131 and newly added claim 136 are also patentable over Safar in view of Kantrowitz. Applicants submit that the combination cited by the Examiner is improper. In connection with combining references to support an assertion of obviousness, the Examiner bears the burden of establishing a prima facie case. The burden is not met simply because the devices of the prior art are analogous in the art. To do so, there must be a clear motivation to

combine the references found in the prior art. See Al-Site Corp. v. VSI International, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999).

By way of background, Kantrowitz discloses an intra-aortic balloon pump apparatus for inflating and deflating synchronous with the pumping of the heart to reduce the load on the left ventricle and increase the amount of coronary blood flow. The apparatus includes a balloon catheter 2 and a pressure transducer catheter 8. Pressure transducer catheter 8 is passed through a central tubular member 5 of balloon catheter 2 such that a distal end of transducer catheter 8 having a pressure transducer 11 carried thereon extends beyond the distal end of balloon catheter 2. The balloon of Kantrowitz's catheter is not designed to occlude or anchor the balloon catheter in place within the aorta. See col 1, lines 12-23. In addition, Kantrowitz does not teach or disclose positioning the catheter at any particular place in the aorta. Instead, the system of Kantrowitz is described as being positioned within the thoracic aorta. Col 1, line 20.

Returning to the rejection of claims 131 and 136, neither Safar nor Kantrowitz provides clear motivation to combine. Safar does not contain any mention of a need to reduce the profile of the balloon catheter described therein, and Kantrowitz does not describe that its means of reducing a balloon profile is applicable to devices other than balloon pumps. As such, one skilled in the art would not look to Kantrowitz to solve a problem not recognized in Safar, and one would not look to Safar to solve a problem identified in Kantrowitz. As such, a combination of Safar and Kantrowitz is improper. Because claims 131 and 136 are patentable over the references separately, Applicants request the Examiner to withdraw the rejection.

Regarding the rejection as it applies to claims 132 and 133, the claims have been amended to claim that the aortic catheter includes a pressure transducer that is carried on the shaft distal to the inner tubular member. As discussed above, the pressure transducer of Kantrowitz is carried on a separate catheter, referred to as reference numeral 8. Neither Safar nor Kantrowitz teach or suggest such a construction, and as a result, Applicants submit that claims 132-133 are allowable, and request the Examiner to withdraw the rejection.

If the Examiner believes that a discussion of the pending claims would expedite the prosecution of this application, she is invited to contact the undersigned.

Respectfully submitted,

By: bsl
Brian S. Tomko, Reg. No. 41,349

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-1239
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